

S.S.N. 09/911,367

Atty. Dkt. No. 032026-0594

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LANDIS *et al.*

Title: DIAZAPHOSPHACYCLES

Appl. No.: 09/911,367

Filing

Date: July 23, 2001

Examiner: Jon D. Epperson

Art Unit: 1639

<p>CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: MAIL STOP Issue Fee, Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450, on the date below.</p> <p>Bernard P. Friedrichsen (Printed Name)</p> <p><i>Bernard P. Friedrichsen</i> (Signature)</p> <p><i>February 20, 2004</i> (Date of Deposit)</p>
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**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
DETERMINATION UNDER 35 U.S.C. § 154(b)(3)(B)(ii)**

MAIL STOP Issue Fee
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants are in receipt of the Notice of Allowance dated February 10, 2004, allowing claims 24, 29-32, 37-39, and 44-47. The issue fee has not yet been paid for this application. Applicants thank Examiner Epperson for allowing the claims of the application. However, Applicants disagree with the Determination of Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) and present the following facts set forth in 37 C.F.R. § 705 to support their contention that the patent term adjustment should be 372 days based on the projected grant date instead of the 211 days calculated by the United States Patent and Trademark Office (USPTO).

BASIS FOR THE ADJUSTMENT

A Notice to File Missing Parts was mailed to Applicants on September 26, 2001, with a due date for response of November 26, 2001. Applicants filed a Response to the Notice to File Missing Parts on November 30, 2001, along with a Petition for One

Month Extension of time, two (2) executed Declaration and Power of Attorney forms (the first executed by three of the four inventors including Clark R. Landis, Wiechang Jin, and Thomas P. Clark, and the second executed by the fourth inventor, Jonathan S. Owen), two checks for the requisite filing and petition fee, and a return receipt postcard. Applicants received the return receipt postcard for the Response to the Notice to File Missing Parts stamped as received by the Office of Initial Patent Examination (OIPE) on January 11, 2002 (copy enclosed). The OIPE-stamped return postcard indicated that both Declarations had been received. A Notice of Incomplete Reply was mailed to Applicants on February 26, 2002, which erroneously indicated that the signature of inventor Jonathan S. Owen was missing from the Declaration. In response, Applicants filed a Response to Notice of Incomplete Reply on March 5, 2002, via facsimile to Joyce Riley of the USPTO, that included copies of each of the documents filed on November 30, 2001, including the OIPE-stamped return postcard, and requested that the Notice of Incomplete Reply be withdrawn. On March 6, 2002, Applicants further filed via first class mail, a Response to the Notice of Incomplete Reply that also included a copy of each of the documents filed on November 30, 2001, a copy of the OIPE-stamped return postcard, and a new return receipt postcard for the filing of the Response to Notice of Incomplete Reply. Applicants again requested withdrawal of the Notice of Incomplete Reply.

The Calculation of PTA by the USPTO, as shown in the following Table copied from the USPTO website, shows that the USPTO calculated the PTA using an Applicant delay of 145 days for late response to the Notice of Missing Parts mailed on September 26, 2001. As explained above, Applicants filed a complete response to the Notice to File Missing Parts on November 30, 2001, which is indicated as received by the OIPE on January 11, 2002, on the enclosed return postcard. Based on these facts, Applicants' calculations of Applicant delay is a total of 16 days rather than the 145 calculated by the USPTO. As shown in the following table, USPTO delays, as calculated by the USPTO total 356 days. **Applicants are therefore entitled to at least 340 days of PTA** (356 (USPTO delay) – 16 (Applicant delay) = 340. However, Applicants are also entitled to **an additional 32 days of patent term adjustment** for

the period of time that is three years from the filing date to the patent grant date.

Therefore, Applicants respectfully submit that they are entitled to a total of 372 days of patent term adjustment.

The Commissioner is hereby authorized, in accordance with 37 CFR § 1.16-1.17, to charge Deposit Account No. 50-2350 for the fee of \$200.00 to cover the requisite fee associated with filing this request as specified in 37 C.F.R. § 1.18(e) and 37 C.F.R. § 1.705(b)(1). Furthermore, the Commissioner is hereby authorized to charge any additional fee(s) which may be required regarding this application under 37 CFR § 1.16-1.17, or credit any overpayment to Deposit Account No. 50-2350. A duplicate of this document is enclosed for such purpose.

PTO Calculation of Patent Term Adjustment of 211 Days from USPTO PAIR page

Patent Term Adjustment (PTA) for publication number: 09/911,367			
			Days
Filing or 371(c) Date:	07-23-2001	USPTO Delay (PTO):	356
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL):	145
Post-Issue Petitions (days):	+0	Total PTA:	211
USPTO Adjustment (days):	+0	Explanation of Calculations	

Patent Term Adjustment History				
Number	Date	Contents Description	PTO (days)	APPL (days)
28	02-10-2004	Mail Notice of Allowance	4	
27	02-10-2004	Mail Examiner's Amendment	↑	
26	02-09-2004	Notice of Allowance Data Verification Completed	↑	
25	02-09-2004	Examiner's Amendment Communication	↑	
24	02-09-2004	Notice of Allowability	↑	
23	11-19-2003	Date Forwarded to Examiner	↑	
22	10-06-2003	Response to Election / Restriction Filed	↑	
21	09-10-2003	Mail Restriction Requirement	352	
20	09-08-2003	Requirement for Restriction / Election	↑	
19	07-09-2003	Case Docketed to Examiner in GAU	↑	
18	03-23-2003	Case Docketed to Examiner in GAU	↑	
17	03-07-2003	Case Docketed to Examiner in GAU	↑	
16	05-22-2002	Application Dispatched from OIPE	↑	
15	05-20-2002	Application Is Now Complete	↑	
13	05-20-2002	Application Dispatched from OIPE	↑	
12	05-20-2002	Application Is Now Complete	↑	145
10	03-14-2002	Additional Application Filing Fees	↑	↑
9	03-14-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	↑
8	01-11-2002	Payment of additional filing fee/Preexam	↑	↑
7	01-11-2002	An assertion that the nature of the legal entities having property rights to the patent authorizes t	↑	↑
6	01-11-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	↑
5	09-26-2001	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	↑
3	09-25-2001	Correspondence Address Change	↑	
2	07-31-2001	IFW Scan & PACR Auto Security Review	↑	

Corrected Calculation of Patent Term Adjustment of 372 days

Patent Term Adjustment Calculation System				
Docket Number: 032026-0594 Application Number: 09/911367 Patent Number: N/A				
Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Application Filing Date	07/23/2001	0		
Notice to File Missing Parts	09/26/2001	65		
Notice to File Missing Parts + 3 months	12/26/2001	156		
Response to Notice to File Missing Parts	01/11/2002	172		16
14 month From Application date	09/23/2002	427		
Restriction Requirement	09/10/2003	779	352	
Restriction Requirement Response Received at PTO	10/06/2003	805		
Restriction Requirement Response Filed + 4 months	02/06/2004	928		
Notice of Allowance	02/10/2004	932	4	
3 Year Period Starts	07/23/2004	1,096		
Projected Patent Grant Date	08/24/2004	1,128	32	
Totals:			388	16
PTA:			372	

Respectfully submitted,

Date February 20, 2004By Bernard P. FriedrichsenFOLEY & LARDNER
Customer Number: 23524**23524**

PATENT TRADEMARK OFFICE

Telephone: (608) 258-4281

Facsimile: (608) 258-4258

Bernard P. Friedrichsen
Attorney for Applicant
Registration No. 44,689



U.S.S.N. 09/911,367

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**STATEMENT OF SUBSTANCE OF INTERVIEW IN COMPLIANCE WITH
MPEP § 713.04**

MAIL STOP Issue Fee
Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Dear Examiner Epperson:

This communication is responsive to the telephonic interview conducted on January 29, 2004 with Examiner Epperson, and the Interview Summary included with the Notice of Allowability dated February 10, 2004. This document is thus filed within one month of the telephonic interview and within one month of the mailing date of the Interview Summary and is timely filed.

Applicants do not believe that any fee is due for this filing. However, should any fee(s) be due, the Patent Office is hereby authorized to charge any such fee(s) which may be required regarding this application under 37 CFR §1.16-1.17 or credit any overpayment to Deposit Account No. 50-2350. A duplicate of the first page and signature page of this document are enclosed for such purpose.

Remarks begin on page 2 of this document.

REMARKS

On January 29, 2004, Examiner Jon D. Epperson and Applicants' representative, Bernard P. Friedrichsen, discussed each of the pending claims of the application. Examiner Epperson indicated that each of the elected claims (claims 24, 29-32, 37-39, and 44-47) were allowable over the prior art of record although no specific prior art was discussed. The Examiner requested permission to cancel the non-elected claims (claims 1-23, 25-28, 33-36, 40-43, and 48-54) of the application. Applicants' representative authorized Examiner Epperson to cancel the non-elected claims without prejudice to Applicants' rights to pursue such claims in one or more timely filed divisional or continuation application(s). Applicants' representative also authorized Examiner Epperson to amend claim 37 by inserting the word "wherein" in the manner set forth in the Notice of Allowability. Therefore, agreement between the Examiner and Applicants' representative was reached. No exhibits were shown or demonstrated.

CONCLUSION

Each of the pending claims of this application (claims 24, 29-32, 37-39, and 44-47) has been allowed and a Notice of Allowability (PTOL -37) and a Notice of Allowance and Fee(s) Due (PTOL-85) have been received by Applicants. The Examiner is invited to telephone the undersigned at the number listed below if the Examiner believes such would be helpful in advancing the application to issuance.

Respectfully submitted,

Date February 20, 2004

By Bernard P. Friedrichsen

FOLEY & LARDNER
Customer Number: 23524

23524

PATENT TRADEMARK OFFICE
Telephone: (608) 258-4281
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Bernard P. Friedrichsen
Attorney for Applicant
Registration No. 44,689

THE U.S. PATENT AND TRADEMARK OFFICE OFFICIAL
MAILROOM STAMP AFFIXED HERETO ACKNOWLEDGES
RECEIPT OF THE ITEMS CHECKED BELOW:

MAILED VIA FIRST CLASS

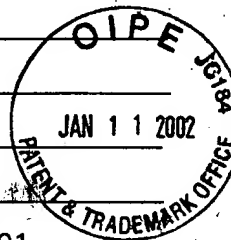
Serial No.: 09/911,367

Applicant(s): Landis, et al.

Filed: July 23, 2001

Title: DIAZAPHOSPHACYCLBS

Date Mailed: November 30, 2001



- [X] Transmittal of Missing Parts of Patent Application (1 page) (duplicate)
- [X] ~~Copy~~ Two (2) Signed Declaration and Power of Attorney forms (4 pages each)
- [X] Copy of Notice to File Missing Parts (Part 2) (1 page)
- [X] Petition for Extension of Time Under 37 C.F.R. § 1.136(a) (2 pages) (duplicate)
- [X] Check No. 614390; \$741.00
- [X] Check No. 614388; \$55.00

DOCKET NO.: 032026:0594

Atty.: BPF

Sjd